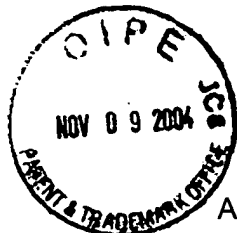


1FW



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Luca Ceruti, et al. Examiner: Geraldine Letscher  
Serial No. 10/696,873 Group Art Unit: 1752  
Filed: October 30, 2003 Docket No. 01025US01  
Title: **SILVER HALIDE PHOTOGRAPHIC EMULSION AND  
PHOTOGRAPHIC ELEMENT COMPRISING IT**

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MAIL STOP: AMENDMENT  
P.O. BOX 1450  
Commissioner for Patents  
Alexandria, VA 22314-1450

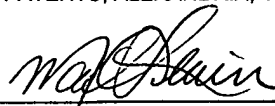
**SUPPLEMENTAL CORRESPONDENCE WITH AMENDMENT AND  
RESPONSE TO NON-FINAL OFFICE ACTION  
UNDER 37 C.F.R. §1.111**

Dear Sir:

This Supplemental Correspondence is with respect to the Amendment filed in response to the Office Action mailed on June 4, 2004. The U.S. Patent and Trademark Office is authorized to debit Attorney's Deposit Account No. 50-1391 for all fees and charges associated with this Amendment, including, but not limited to, Fees for a Two-Month Extension of Time.

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Letter is being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: MAIL STOP: AMENDMENT, P.O. BOX 1450; COMMISSIONER FOR PATENTS, ALEXANDRIA, VA 22313-1450 on November 5, 2004.

Mark A. Litman  
Name

  
Signature

## **RESPONSE TO THE REJECTION**

The sole ground of rejection in this Application is a rejection under 35 USC 102(e) with respect to common assignee's U.S. Patent No. 6,664,038 (Ceruti et al.)

In the Office Action, one method for overcoming the rejection was a showing under 37 C.F.R. 1.132 was derived from the inventor of this Application. Applicants have complied therewith.

Accompanying this Amendment is the Declaration of Eva Genesio, the fourth inventor on the Cerutio et al. Patent, to be considered with the declarations of Gianluigi Molinari, Luca Ceruti and Ivo Zullo, the remaining three inventors on the Ceruti et al. Patent, U.S. Patent No. 6,664,038. The Declarations of the remaining three inventors were mailed in separately.

The Declarations by all of the inventors on the Ceruti patent (US 6,664,038) assert that the subject matter of the claims in US Patent Application Serial No. 10/696,893 (the present application) that was disclosed in the Ceruti patent, but not claimed in the Ceruti Patent was "derived from Luca Ceruti and Simona Fava in contemporaneous work performed among the four inventors."

This statement is highly consistent with the obvious fact, even beyond the scope of the subject matter, that the present application and the Ceruti Patent share one inventor, so that the common awareness of subject matter between the different inventorship entities of the two Patent Documents was inherent.

Applicants have met their burden of a showing under 37 C.F.R. 1.132 in this Application, and the rejection of record should be withdrawn.

### Conclusion

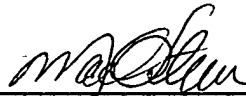
The rejection of record has been overcome by the present response and the accompanying Declarations. The rejection should be withdrawn and all claims allowed.

Luca Ceruti et al.

By their Representative

MARK A. LITMAN & ASSOCIATES, P.A.

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By:  11/5/04  
Atty: Mark A. Litman  
Reg. No. 26,390